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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,767	09/29/2003	Shinichiro Takami	O11.2B-11336-US01	2475

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VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,767

Applicant(s)

TAKAMI, SHINICHIRO

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12 and 18-20 are indefinite as to the added limitations (both occurrences) because the examiner is unclear as to this limitation means and encompasses. The newly added limitation is defined using phraseology that unclear to the examiner and confusing and it is strongly suggest that this be deleted since it is unnecessary and makes the claim difficult to understand. Specifically, what is meant by "lastly integrated in integrating the volume of each particle"? These limitation are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Are applicants trying to define a program and what being integrated?

The disclosure is objected to because of the following informalities:

The disclosure is objected to as to the limitation "lastly integrated in integrating the volume...the total of the volumes (page 4, lines 13-16 and lines 23-26) because the examiner is unclear as to this limitation means and encompasses. This limitation is defined using phraseology that unclear to the examiner and confusing. Specifically, what is meant by "lastly integrated in integrating the volume of each particle"? These limitation are generally narrative and indefinite,

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failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Are applicants trying to define a program and what being integrated? Appropriate correction is required.

This objection is in view of applicants amendments to the claims.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Tredinnick et al., (2) Inoue et al. (672), or (3) Tsuchiya et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-8 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki, as applied to claim 1 above and further in view of Tsuchiya et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (652) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (652), as applied to claim 1 above and further in view of Tsuchiya et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Koichi et al. or (2) Hagihara et al. or (3) Oshima all in view of Tsuchiya et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive.

With respect to the previous indefinite rejection, this has been withdrawn because the claims no longer define the limitation "are smaller". However, as defined above, the examiner is unclear as to what the newly added limitations are defining and thus how do these limitations make the claim definite (apparently this amendment was made to overcome the indefiniteness of the limitation "are smaller" and how do these amendments make the claim definite and how do define smaller?).

With respect to the art rejections, applicants argue that the references do not teach the combination of features recited in the claims. As clearly defined in the last office action, the claimed features are (1) encompassed by the disclosure of the reference and (2) if not literally disclosed, obvious for the reasons defined in the last office action. Applicants apparently argue that table 1 shows criticality for the claimed combination. This is not persuasive because (1) the table does not compare the claimed invention with the disclosure of the references and (2) applicants have not clearly established criticality for the claims. The examiner is aware of the examples and comparative examples, however, these results are not persuasive because the comparative examples only use specific alkaline compounds and specific water soluble

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polymers, whereas the claims (specifically the independent claims) define alkaline compounds and water soluble polymers, in general. To the extent that the examples and comparative examples include all of the water soluble polymers according to dependent claim 8, as defined in the specification, the water soluble polymers are only limited to polymers having a specific molecular weights, thus how can a comparison be used to establish criticality of the claims when the claimed water soluble polymer does not require any molecular weight for the water soluble polymer. At most criticality might be shown for the specific water soluble polymers of the specific molecular weight. *To make a jump that all molecular weight water soluble polymers will provide similar results (without any evidence to the contrary) is improper.* As a further comment, the comparative examples are only limited to specific alkaline compounds in combination with specific water soluble polymers, thus how can these comparative examples which use specific combinations be used to show criticality for a composition, as in claim 1, wherein the combination of alkaline compounds and water soluble polymers are not limited (i.e. the broad interpretation of the independent claim 1 includes an extremely large permeation of possible combinations which is clearly much broader than the example and comparative example combinations defined. In addition, the tables use specific proportions of components and the instant claims do not define any proportions so how can the tables, which use specific amounts for the individual components be used to establish criticality for a composition (as in the claims) which does not require any specific amounts. In other words, how can specific amounts establish criticality for any and all amounts? In view of the above, the evidence of unexpected results is not clear and convincing. Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. In addition, evidence of unexpected results must be

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commensurate in scope with the subject matter claimed. In re Linder 173 USPO 356. As is extremely clear, the evidence defined in the table is not commensurate in scope with the extremely broad claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any foreign language documents submitted by applicant has been considered to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

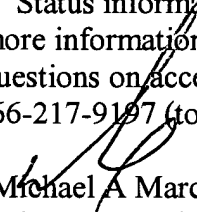
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/05
MM


Michael A Marcheschi
Primary Examiner
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